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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,915	11/29/2001	Bhupesh Gupta	AUS920010888US1	6707

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Mr. Volel Emile
P.O. Box 202170
Austin, TX 78720-2170

EXAMINER

SAIN, GAUTAM

ART UNIT PAPER NUMBER

2176

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,915

Applicant(s)

GUPTA, BHUPESH

Examiner

Gautam Sain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1) This is a Supplemental Final Rejection (to supplement Final Rejection mailed on 7/26/05) because the Examiner missed addressing the newly added claim 33.

Applicant did not request restarting of the time period set for reply. The Examiner notified the applicant of the option to restart the time period but the applicant waived restarting the time period if the missing claim is addressed within a reasonable time period, allowing applicant ample time to respond. This Final Office Action is in response to Amendment dated 11/28/04 and supplemental amendment dated 5/17/05.

2) Claims 1-33 are pending and finally rejected.

3) Examiner withdraws the 35 USC 101 rejection because Applicant amended to overcome possible issues.

4) Examiner maintains the substantive art rejections under 35 USC 102(b) for claims 1-32 and responds to the Applicant's arguments (see Response to Arguments section below).

5) Applicant amended independent claims 1, 9, 17 and 25 for more definiteness. The Examiner reasonably proceeds with the belief that the amendment was not made to overcome prior art rejections and was made to clarify and better state the language of the claims (as stated in Applicant's REMARKS, page 14, 3rd paragraph, last sentence). Therefore, the Examiner asserts the prior art reference, Burke, to include anticipating these amendments.

6) Examiner applies a 35 USC 103 rejection for new claim 33.

Claim Rejections - 35 USC § 102

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6-1) Claims 1-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke (US 6032162, issued Feb 29, 2000).

Regarding claims 1, 9, 17, 25, Burke teaches determining ... on a server (ie., URL file to identify HTML tags for type indicators to see if it belongs to previously stored category)(col 4, line 65 – col 5, lines 20).

Burke teaches downloading ... a category (ie., bookmarks previously stored ... sub-category of topics ... stock prices ...)(col 5, lines 8-24; col 7, lines 10-15).

Burke teaches creating ... in the bookmark folder ... name (ie., bookmarks categorized by theme/topic under master set of themes/topics)(col 5, lines 8-24).

Burke teaches storing ... sub-folder (ie., collates and merges set of bookmarks)(col 5, lines 8-24).

Regarding claims 2, 10, 18, 26, Burke teaches determining ... creating the sub-folder (ie., determining if previously stored file of bookmarks does not exists, then controller creates a file)(col 5, lines 54-60).

Regarding claim 3, 11, 19, 27, Burke teaches if there already ... not created (ie., controller collates in designated files – which encompass sub-categories)(col 5, lines 8-20).

Regarding claims 4, 12, 20, 28, Burke teaches if the Web page ... sub-folder (ie., for a file where a bookmark does not exist, the controller stores the collated non-merged bookmarks in the created file with only user identification information)(col 5, lines 54-61).

Regarding claims 5, 13, 21, 29, Burke teaches if the Web page ... assigned a category (ie., user can select and transfer data from bookmarks stored in the downloaded system which is requested by the user using the URL and the system returns the file and corresponding information)(col 6, lines 15-23).

Regarding claims 6, 14, 22, 30, Burke teaches after web page has been assigned a category ... default sub-folder (ie., the downloaded bookmark has a theme or topic which is more than the default useid and password file)(col 5, lines 10-20; lines 54-60).

Regarding claims 7, 15, 23, 31, Burke teaches determining ... creating the sub-folder (ie., determining if previously stored file of bookmarks does not exists, then controller creates a file)(col 5, lines 54-60).

Regarding claims 8, 16, 24, 32, Burke teaches if there already ... existed sub-folder (ie., previously stored file with theme and topic)(col 5, lines 8-20).

Claim Rejections - 35 USC § 103

7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7-1) Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (as cited above).

Regarding claim 33, Burke teaches determining, ... remote computer system (ie., URL file to identify HTML tags for type indicators to see if it belongs to previously stored category)(col 4, line 65 – col 5, lines 20).

Burke teaches downloading ... category (ie., bookmarks previously stored ... sub-category of topics ... stock prices ...)(col 5, lines 8-24; col 7, lines 10-15).

Burke teaches determining ... folder on the local computer system (ie., determining if previously stored file of bookmarks does not exists, then controller creates a file)(col 5, lines 54-60).

Burke teaches storing ... sub-folder (ie., collates and merges set of bookmarks)(col 5, lines 8-24).

Burke teaches creating ...in the bookmark folder ... for the sub-folder (ie., bookmarks categorized by theme/topic under master set of themes/topics)(col 5, lines 8-24).

Burke teaches storing ... sub-folder (ie., collates and merges set of bookmarks)(col 5, lines 8-24).

Burke does not teach determining whether a web page is to be bookmarked on the local computer system, but does suggest the limitation (ie., Burke teaches establishing FTP compatible communication with system and controller downloads the User designated file requested by the User to terminal from system. To establish compatibility, the user's terminal must perform a determination step with the local bookmarks)(col 5, line 65 – col 6, lines 15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Burke to include establishing an FTP compatible communication with system and controller downloading the user designated file request by the user terminal, providing the benefit of overcoming user's deprivation of the use of his bookmark file for Internet overload disruptions or because of loss of server storage (col 1, lines 25-33).

Response to Arguments

8) Applicant's arguments filed 11/28/04 have been fully considered but they are not persuasive. Applicant argues (starting at bottom of page 16 of REMARKS section) that Burke does not teach, show or so much as suggest bookmarking pages by first **determining whether a server has assigned a category to the page** as claimed.

However, the applicant also asserts that "Nor does Burke need to show such limitation."

This is very confusing and contradictory because the Applicant does not provide analysis as to why Burke does not need to show such limitations and thus leads to a few leaps of logic to arrive at varying interpretation. The Applicant merely states what Burke does teach and what is not directed towards. With the ambiguous and unsupported assertion by the Applicant, it would be reasonable for the Examiner to interpret that the Applicant is conceding that this feature is well known or inherent in the art, and that Burke does not need to show such limitation. In fairness, the Applicant is not expressly asserting such an interpretation either. If the Applicant is asserting (and the Applicant is on the bottom of page 16) simply that Burke does not teach the limitation of "determining whether a Web page to be bookmarked has been assigned a category on a server," then the statement "Nor does Burke need to show such

limitations" is redundant and unnecessary because it is clearly asserted in the previous sentence. In order to properly understand the Applicant's position for the record and the benefit of the Applicant, The Examiner encourages the Applicant to further clarify this statement by providing reasons as to 'why' Burke does *not need to show such limitations*, without leaving room for ambiguity and multiple contradictory interpretations of the assertion.

For the purposes of advancing prosecution of this application, the Examiner is responding to the first assertion of the paragraph that starts at the bottom of page 16, that Burke does not teach, show or so much as suggest bookmarking pages by first **determining whether a server has assigned a category to the page** as claimed. Specifically, the Applicant's basis for this broad assertion is that that Burke is directed to storing bookmark files into remote systems such that users may always have access to the bookmark files and is not directed to bookmark Web pages in proper categories. Applicant is saying that essentially this allegedly untaught limitation "determining ..." is to be interpreted as merely "bookmarking web pages in proper categories," see REMARKS section, page 17. The Examiner disagrees that this limitation is suggested, at the very least inherently because in order to categorize a bookmark for the first time, the controller of Burke must determine that the bookmark is not yet categorized/classified/merged, else there would be no bookmarks stored. Even if Burke is directed towards such technology that Applicant alleges on top of page 17, it is not precluded from suggesting or teaching (expressly or inherently) the technology of bookmarking web pages in proper categories and in fact Burke does not preclude such

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teaching. Specifically, file contents are parsed in order to identify HTML tags that identify HTML statements (col 5, lines 1-3) such that the controller collates the bookmarks by categorizing the bookmarks by theme and topics according to a master set of theme and topics codes (col 5, lines 10-20). In order to do this, it is inherent for the controller to classify the bookmarks to properly categorize them. The controller creates a file and stores the collated non-merged bookmarks in the created file (col 5, lines 58-61). This shows that a distinction is made for bookmarks not merged in the file and if it not merged, then it is to be merged and will be collated and categorized by theme and topic.

Conclusion

9) Applicant's amendment (adding claim 33) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GS

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
8/21/2005